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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/227,593 01/08/99 BESSE

M 730.010US1

EXAMINER

023552 IM52/1025
MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS MN 55402-0903

TOOMER, C
ART UNIT PAPER NUMBER

1714
DATE MAILED:

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10/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/227,593

Applicant(s)

BESSE ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2000.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed September 25, 2000 in which the specification at page 9, line 4 was amended; claims 1-30 were canceled and claims 31-108 were added.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31, 45, 70, 84 and their dependents are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner has considered Applicant's arguments, the provided case law and the MPEP section 2163. However, it is the examiner's position that the language "substantially free of fatty acid" is new matter. The examples of the present invention are devoid of fatty acids. Applicant discloses that fatty acids are present in the prior art compositions. Applicant discloses that the use of compositions, such as those of the present invention, provide increased lubricity. This evidence is sufficient to support use of the language "free of fatty acid". However, by appending the term "substantially" to this language introduces new matter.

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MPEP, section 2173.05 (b) D, recites "[T]he term substantially is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term." A composition that is "substantially free" of a component may contain ²th~~a~~ component in amounts that ^eare ^{ve}well about contamination levels. Therefore, it is the examiner's position that the specification does not support a composition that is "substantially free of fatty acid."

Claims 40, 41, 79, 80, 104 and 105 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the C₁₂–C₁₅ linear alcohols with 7 ethylene oxide units, does not reasonably provide enablement for all alkoxyated alcohols. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. There is no mention in the specification of alkoxyated alcohols except for the very specific compound that appears in the examples.

The rejection of the the claims under 35 USC 112, first paragraph, (enablement) is withdrawn in view of Applicant's new claims that recite that the alkyl and aryl phosphates are alkoxyated.

The rejection of the claims under 35 USC 112, second paragraph, is withdrawn in view of Applicant incorporating the suggested corrections in to the newly added claims.

It should be noted that in claims 44, 69, 83 and 108, the C₁₂₋₁₅ linear alcohol should be amended to read -- C₁₂₋₁₅ linear alcohol with 7 ethylene oxide units --.

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Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 31-42, 46-67, 70-81 and 84-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Despo (US 5,391,308) in view of Liu (US 5,244,589).

Despo teaches an aqueous lubricant having utility as a conveyor lubricant. The lubricant comprises C₈-C₁₂ alkyl alkoxyated phosphate, and C₈-C₁₀ alkylaryl alkoxyated phosphates, sequestering agents (EDTA) and a metallic hydroxide (encompasses sodium hydroxide) (see abstract; col. 5, line 55 bridging col. 6, lines 1-50). Despo teaches the limitations of the claims other than the differences which are discussed below.

In the first aspect, Despo differs from the claims in that he does not specifically teach that the composition of his invention contains a quaternary ammonium antimicrobe agent. However, Liu teaches this difference in a similar composition (see abstract; col. 2, lines 42-56).

It would have been obvious to one of ordinary skill in the art to have included the quaternary compound of Liu in the composition of the Despo because Despo teaches aqueous conveyor lubricants and Liu teaches that lubricants of this nature obtain improved load bearing properties and excellent antimicrobial properties upon addition of the quaternary ammonium compound.

In the second aspect, the prior art differs from the claims in that it does not specifically teach the ratio of phosphate/quaternary ammonium compound. However,

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no unobviousness is seen in this difference because where the general conditions of the claims are disclosed in the prior art it is not inventive to determine the optimum amount of the components through routine experimentation.

In the third aspect, the prior art fails to teach the claimed pH of the lubricant. However, it would have been obvious to one of ordinary skill in the art to have selected the claimed pH range because where the general conditions of the claims are disclosed in the prior art it is not inventive to determine the optimum pH range through routine experimentation.

Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that both Despo and Liu include fatty acid and, therefore, do not teach or suggest the claimed invention.

Despo teaches that as little as 0.5 percent of fatty acid may be present in his composition. This percentage clearly renders obvious Applicant's claims with respect to "substantially free of fatty acid."

Applicant argues that Despo does not contain a quaternary ammonium antimicrobial agent and therefore cannot disclose the claimed ratio of phosphate ester/quaternary compound.

Despo teaches that he takes a conventional conveyor lubricant and modifies it by adding the components of his invention (see Examples). Liu teaches that conventional conveyor lubricants contain quaternary ammonium compounds. Given these two disclosures, it would not be inventive to determine the workable ranges through routine experimentation.

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Applicant argues that Liu teaches using an excess of cationic compound to anionic.

Liu is relied upon for teaching that it is conventional to add quaternary compounds to conveyor lubricants. The skilled artisan would be able to determine the appropriate proportions of the phosphate ester and the quaternary ammonium compound through routine experimentation.

Claims 31-36, 38-42, 45-60, 63-67, 70-75, 77-81, 84-99 and 102-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Person Hei (US 5,723,418) in view of Liu (US 5,244,589).

Person Hei teaches a conveyor lubricant composition comprising water, corrosion inhibitors, such as alkyl and aryl alkoylated phosphates, and surfactants, such as quaternary ammonium chloride and nonionic alkoxyated alcohols (see abstract; col. 2, line 50-67; col. 4, lines 1-10; col. 5, lines 10-25). The corrosion inhibitors are present in an amount from 0.05 to 25% (see col. 4, lines 23-28) and the surfactants are present in an amount from 0.01 to 50 wt % (see col. 5, lines 35-40). The pH of the solution is between 5 and 10 (see col. 4, lines 31-33). Person Hei teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Person Hei differs from the claims in that she does not specifically teach that the quaternary compounds are linear. However, Liu teaches this difference (see col. 5, line 47 through col. 6, lines 1-5).

It would have been obvious to one of ordinary skill in the art to have substituted linear quaternary compounds for the aryl quaternary compounds of Person Hei because

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Liu teaches that these compounds are equivalent for the purpose of imparting antimicrobial properties to conveyor lubricants.

In the second aspect, Person Hei differs from the claims in that she does not specifically teach the ratio of phosphate ester/quaternary ammonium compound. However, no unobviousness is seen in this difference because where the general conditions of the claims are disclosed in the prior art it is not inventive to determine the optimum proportions through routine experimentation.

In the third aspect, Person Hei differs from the claims in that she does not specifically teach that the composition of her invention contains a chelating agent (sequestrant). However, Liu teaches this difference (see col. 7, line 60 through col. 8, lines 1-7).

It would have been obvious to one of ordinary skill in the art to have included a chelating agent in the composition because Liu teaches that these compounds chelate hardness components in the service water into which the conveyor lubricant is dispensed.

Person Hei fails to disclose a composition wherein the alkyl and aryl alkoxylated phosphate esters are both present or a composition wherein the cationic surfactant (quaternary compound) and the nonionic surfactant (alkoxylate alcohols) are both present. However, it is prima facie obvious to combine two components each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. In re Kerkhoven, 205 USPQ 1069 (CCPA 1980).

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Cephia D. Toomer
Patent Examiner-1714

09/227593.cp2
October 22, 2001


MARGARET MEDLEY
PRIMARY EXAMINER